



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/118,351

07/17/98

DAVID HOYLE

M

P-3001-1/L&M

EXAMINER

LM02/1130

JAMES D. STEVENS
REISING ETHINGTON LEARMAN & MCCULLOCH
PO BOX 4390
TROY MI 48099-4390

JACKSON, C

ART UNIT

PAPER NUMBER

2773

DATE MAILED:

11/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

00/118,351

Applicant(s)

Hoyle

Examiner

C. Jackson

Group Art Unit

2773

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9/28/99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-43 is/are pending in the application.
- Of the above claim(s) 11-20, 26-36 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-10, 21-25 and 37-43 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 2773

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of claims 1-10, 21-25 and 37-43 in Paper No. 6 is acknowledged.
2. Claims 11-20 and 26-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made without traverse in Paper No. 6.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown, M "Using Netscape 3" (hereinafter "Netscape").

As per claims 21 and 23, Netscape teaches a browser operable upon execution to display a window separated into a number of regions including a menu bar (i.e., second region) with menu items selectable by a user, each menu item having an associated function, a bookmark list window (i.e., third region) with selectable folders used to categorize URLs that provide access web pages,

Art Unit: 2773

a location bar (i.e., fourth region) enabling a user can go directly to a web page by typing the URL, a banner region (i.e., fifth region) that displays an advertisement, and a home page button (i.e., display object) that allows a user to access a local HTML file that is stored on the hard drive as the home page. Moreover, Netscape teaches a button region below the location bar provided with a software button that enables the user to access and launch applications. See Netscape, pages 40, 43, 52, 53, 58, 59, 62-64 and 94-109.

As per claim 22, the browser is provided with a tool bar that includes buttons associated with various Internet related activities as well as menu activities.

As per claims 24 and 25, selection of a folder icon reveals URLs, and the window can be manipulated independently.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2-7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al. (US Patent # 5,933,811) in view of Brown, M., "Using Netscape 3" (hereinafter "Netscape").

Art Unit: 2773

The Angles '811 patent teaches, as claimed in **claim 1**, a second program module operable upon execution to select informational data to be displayed in said information display region [a consumer control module provided on a client computer as a plug in is operable upon receiving an advertising request to select an appropriate advertisement to be displayed in a place holder of an electronic page, see Angles '811, col. 22, line 9-col. 23, line 56] wherein said first program module is operable in response to selection of a first one of said links to provide the user with access to its associated information resource and to notify said second program module of the selection of said first link [wherein said consumer browser module is operable in response to "user direction" to provide the user with access to a content provided computer and provide an advertisement request associated with said "user direction", see Angles '811, col. 7, lines 53-67, col. 8, lines 33-61, col. 23, lines 15-55]; and wherein said second program module is operable in response to notification from said first program module to select the informational data to be displayed from among a large amount of informational data, said second program module further being operable to store statistical data regarding the display of said selected informational data [wherein the consumer control module is operable in response to an advertisement request from said browser module to select an advertisement from an advertisement database, and further being operable to store audit information regarding the display of said selected advertisement, see Angles '811, col. 15, lines 1-42, col. 23, lines 15-55]. Moreover, the Angles '811 patent teaches the use of consumer browser module, where the module is a software program that enables the display of an electronic pages. However, the Angles '811 patent does not explicitly recite that the

Art Unit: 2773

browser module enables the display of a graphical user interface comprising “*a window separated into a number of regions*” and “*a first one of said regions includes a number of user-selectable items, at least some of which is associated with a different data set.*” Netscape, on the other hand, teaches a browser operable upon execution to display a window separated into a number of regions including a bookmark list window with selectable folders, each of which is associated with URLs that are links responsive to user direction and related to the category associated with the folders. See Netscape pages 94-109. Consequently, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a the browser with a window separated into a number of regions and having selectable items each associated with a different data set because it a software program that allows a user to access different content providers while providing an organized interface.

As per **claim 2**, the advertisement is selected by the consumer control module based on the content provider profile whose URL is selectable and associated with a folder.

As per **claims 3 and 4**, the control module is a plug-in stored on the consumer computer.

As per **claim 5**, the advantages and techniques for requesting an update version of a plug-in and downloading a new version is old and well known in the art.

As per **claim 6**, the electronic document is provided with an advertisement insert and the advertisement is one of many that is stored in an advertisement database. See Angles ‘811, col. 12, lines 51-60, col. 15, lines 20-43.

As per **claim 9**, see discussion of claim 2, supra.

Art Unit: 2773

As per **claim 10**, advertisement module selects an advertisement for display using content provider information provided by the content provider ID in the advertisement request. See Angles '811, col. 15, lines 20-31.

7. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al. (US Patent # 5,933,811) and Brown, M., "Using Netscape 3" (hereinafter "Netscape") in view of Merriman et al. (US Patent 5,948,061).

The combined apparatus of the Angles et al. (US Patent # 5,933,811) and Netscape references do not teach the "*advertisement module selecting and advertisement from a first subset of advertisement in the advertisement database, and in response to each of the advertisements in the first subset being selected a number of times, to select an advertisement from a second subset of advertisements in the advertisement database.*" In contrast, the Merriman '061 patent teaches selecting an advertisement from a database when the number of times the user has seen the advertisement does not exceed a predetermined threshold (i.e., first subset is the set of advertisements which "*initially*" do not exceed the predetermined threshold). In addition, when the number of times a user has seen an advertisement exceeds the threshold, the advertisement is removed as a selection option (i.e., second set is the set of advertisements that remain one an advertisement has been removed because it exceeds the viewing threshold). See Merriman '061, col. 6, lines 11-26. Moreover, the Merriman '061 patent also teaches that continuous exposure to the same advertisement reduces the response rate to the advertisement. Consequently, it would have been obvious to one having ordinary skill in the art at the time the

Art Unit: 2773

invention was made to incorporate the frequency of exposure feature disclosed in the Merriman '061 patent into the combined apparatus of the Angles '811 and Netscape references because it would reduce the amount of exposure a user has to an advertisement and thus improve user response to the advertisement.

8. Claims 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman et al. (US Patent 5,948,061) in view of Netscape.

The Merriman '061 patent teaches, as claimed in claim 37 and 43, a web browser application stored on a user's computer wherein the browser is operable to display web pages on the user's computer, the web pages include a banner region for displaying a plurality of advertisements. The advertisements associated information, such as advertisement id, Standard Industry Codes (SIC codes) that indicate acceptable viewers for an advertisement and pages that the advertisements are viewed. Moreover, the browser is operable in response to user selection of a category of advertisement, specified by SIC code, to display an advertisement currently available that matches the category of advertisement. See Merriman '061, col. 5, line 50-col. 6, line 11. The Merriman '061 patent does not specifically teach that the web page is displayed in a window. However, the Netscape reference teaches providing a browser with a window for displaying a web page. See Netscape pages 40, 43, 52, 53, 58, 59 and 62-64. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a window for displaying a web page because it provides an interface for viewing information accessed by the browser.

Art Unit: 2773

As per **claims 39 and 40**, as discussed above with respect to claim 37, in response to a user's selection of a web page or advertisement the system will display an advertisements corresponding to the SIC code of the selected web page or advertisement.

As per **claim 41**, see col. 7, lines 15-31.

As per **claims 38 and 42**, the invention utilizes SIC codes to associated characteristics of the web site to the web site. Accordingly, one having ordinary skill in the art would recognize that keywords and URLs are substitutes for selecting appropriate advertisements for display.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is provided on PTO form 892.

10. Response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 305-9724 for informal or draft communications. Please label "PROPOSED" OR "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document. Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chadwick A. Jackson, whose telephone number is (703) 308-9572. The

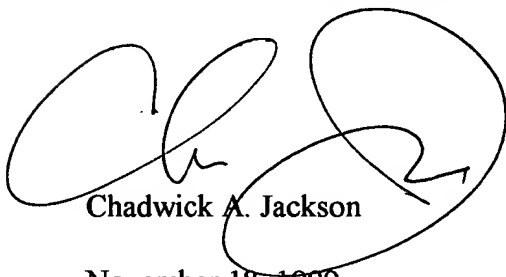
Serial Number: 09/118,351

Page 9

Art Unit: 2773


examiner can normally be reached Mon-Thu from 7:30 a.m. - 6:00 p.m. ET. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached at (703) 305-3821

12. Any inquiry of a general nature or relating to the status of this application or proceedings should be directed to the group receptionist whose telephone number is (703) 305-3900.



Chadwick A. Jackson

November 18, 1999



RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2773